Claim 8 was objected to for informalities. Specifically, claim 8 formally read "wherein said requested primary media content is downloaded only said fixed storage device." Claim 8 has been amended to insert the word to between the words "only" and "said," as requested by the Examiner. Accordingly, Applications respectfully request this objection be withdrawn.

Claim 1 has been amended to include uploading a user identifier to the download management server to enable access to specified content in the primary media content database. Claim 1 further requires the user information to be downloaded into the client console to trigger execution of specified revenue bearing events. Claim 2 has been amended to omit previous limitations now incorporated into claim 1.

Claims 1-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,619,247 to James Russo (Russo) in view of U.S. Patent No. 5,530,754 to Norton Garfinkle (Garfinkle) and U.S. Patent No. 5,809,145 to David Slik (Slik). As will be fully explained below, the combination of the Russo, Garfinkle, and Slik references does not establish a *prima facie* case of obviousness against the subject matter defined in claims 1-12.

Each of the claim elements is addressed separately below, but in general unsupported assertions of what those skilled in art might have done do not provide a level of support which meets the Office's burden of proof. Of course, those skilled in the art *could* have tried to accomplish much had they had the perspectives of and the benefit of hindsight from the present inventors. With the hindsight of these perspectives, they might have even tried to achieve the present invention – but as the art of record poignantly shows, they did not.

In spite of attempts by those skilled in the art to address the problems solved by the present invention, until the present invention, those problems were not solved in the manners claimed. To a large degree, the references cited actually show the exact opposite – that the understanding of those skilled in the art at the time the invention was made did not include the perspective which the present inventors had. To say that those of ordinary skill could have

achieved the various claimed elements and combinations is not only unsupported, but it begs the question. Of course, once traversed, it is improper to maintain an unsupported allegation. As the courts have long stated:

> "[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice. If evidence of the knowledge possessed by those skilled in the art is to be properly considered, it must be timely injected into the proceedings"

In re Eynde, 480 F.2d 1364 (CCPA 1973). See also Ex Parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) and In re Bron, 439 F.2d 724 (1971). Examiners are even cautioned in their training materials against basing rejections on allegations of their personal impressions of what might be a design choice -- essentially what might be obvious. To maintain such allegations, evidence is necessary. Of course, the Applicants have traversed the allegations and -- to the extent not now mooted by the response – request this evidence to support each of the propositions proposed. Further, while several specific allegations are addressed below, this request should be understood to apply to each of the unsupported allegations raised in the action.

Perhaps the most evident example that the aspects are not, in fact, obvious relates to the elements of uploading a user identifier "to said download management server to enable access to specified content in said primary media content database, and said user information is downloaded into said client console to trigger execution of specified revenue bearing events" as recited in independent claim 1.

Indeed, neither the Russo, Garfinkle, nor Slik reference discloses these elements. In particular, the Examiner points to Russo Figure 2 and associate text (col. 5 lines 52-65, col. 6 lines 12-33, and col. 10 lines 10-38). However, Russo describes a client side device, and does

not set forth any specific processes for the server/client interaction. Col. 5 lines 52-65 in Russo sets forth how the client device shows a listing of the programs already recorded on the client device. It says nothing about interacting with the server. Col. 6 lines 12-33, and col. 10 lines 10-38 in Russo discuss providing the user with a predetermined amount of viewing time, and how the user can pay to increase that time. Thus, Russo does not disclose uploading a user identifier to the download management server to enable access to specified content in the primary media content database and downloading user information to the client console to trigger execution of revenue bearing events. Moreover, none of cited references discloses or reasonably suggests alphanumeric media ID that identifies the detachable storage media, as required in dependent claim 2. A similar situation applies to independent claim 9 and dependent claim 10.

Accordingly, independent claims 1 and 9 are submitted to be patentable under 35 U.S.C. § 103 over the Russo, Garfinkle, and Slik references. Claims 2-8 and 10-13, each of which ultimately depends from independent claims 1 and 9 respectively, are likewise submitted to be patentable under U.S.C. § 103 over the Russo, Garfinkle, and Slik references for at least the same reasons set forth above regarding independent claims 1 and 9.

The Examiner also rejected claims 13-16 under 35 U.S.C. §102(e) as being anticipated by Russo. As an aside, Russo issued April 8, 1997, which is prior to the filing date of the present invention. Hence, this is not a proper 102(e) rejection. However, even if Russo could be properly cited, Russo does not anticipate claims 13-16. Referring to independent claim 13, Russo does not download content from a server upon request from a user. In contrast, Russo broadcasts media from a broadcast source and then simply records the broadcast. That is, the broadcast is not performed in response to a user request. Furthermore, Russo is silent as to scheduling the download, or in the case of Russo, the broadcast. Since, Russo does not disclose each and every element of independent claim 13, Russo cannot anticipate claim 13.

Accordingly, independent claim 13 is submitted to be patentable under 35 U.S.C. § 102 over the Russo reference. Claims 14-16, each of which ultimately depends from independent claim 13, are likewise submitted to be patentable under U.S.C. § 102 over the Russo reference for at least the same reasons set forth above regarding independent claims 13.

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 1-16, and submit that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at **(408) 749-6900 x6920**. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. SONYP002). A copy of the transmittal is enclosed for this purpose.

Respectfully submitted,
MARTINE & PENILLA, LLP

Joe A. Brock, II
Registration No. 46,021

710 Lakeway Drive, Suite 170
Sunnyvale, California 94085
Telephone: (408) 749-6900
Customer Number 25,920

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of	Docket No. SONYP002
CHATANI	Group Art Unit: 3621
Application No. 09/632,861	Examiner: Abdi, Kambiz
Filed: August 4, 2000	Date: January 29, 2003
For: NETWORK BASED METHOD AND SYSTEM FOR TRANSMITTING DIGITAL DATA TO A CLIENT COMPUTER AND CHARGING ONLY FOR DATA THAT IS USED BY THE CLIENT COMPUTER USER	

MARKED UP CLAIMS

1. (Amended) A system for providing access to primary media content in digital form, comprising:

a server network comprising a download management server, a customer database storing user information, and a primary content database storing primary media content;

a client console connectable for establishing a communications link through a bi-directional communications network to said download management server;

a detachable storage media installable in said client console; said detachable storage media having a data structure thereon comprising at least one of a user identifier and a media identifier, wherein

the server network is configured to transmit to the client console a plurality of media content items upon request by a user of the client console, and wherein a content provider providing data through the primary content database charges the user only for items used by the user.

and wherein a user identifier is uploaded to said download management server to enable access to specified content in said primary media content database, and said user information is downloaded into said client console to trigger execution of specified revenue bearing events.

2. The system according to claim 1, [wherein a user identifier is uploaded to said download management server to enable access to specified content in said primary media content database, and said user information is downloaded into said client console to trigger execution of specified revenue bearing events,] wherein said user identifier comprises an alphanumeric media ID identifying said detachable storage media.

8. (Amended) The system according to claim 1, wherein said client console further comprises a local fixed storage device disposed internally or externally of said client console, wherein said requested primary media content is downloaded only to said fixed storage device.